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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,995	03/19/2004	Guido Galliani	Q80505	6918

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,995

Applicant(s)

GALLIANI ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 12/27/04 is acknowledged. The traversal is on the ground(s) that the invention as defined in claims 6 and 7 are strictly related to the invention as claimed in claim 1 and that both claims 6 and 7 depend directly on claim 1. This is not found persuasive because claims 6 and 7 are product claims. The product claims could be made by another and materially different process than that recite in claim 1 because the door could be painted after it is installed and still produce the same product. The patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The abstract of the disclosure is objected to because "(Figure 1)" in the last line should be deleted. Correction is required. See MPEP § 608.01(b).

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3. The disclosure is objected to because of the following informalities: all recitations of “the preamble of claim 1” in the specification should be removed. See for example, page 1, lines 6-7.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 and 5** are rejected under 35 U.S.C. 102(b) as being anticipated by Herringshaw et al. (US 4,845,894).

Herringshaw et al. teach a process for assembling motor vehicle bodies, comprising a painting step of a body (col. 4, lines 25-26), in which the body is provided with doors (figure 1) constituted by a load bearing framework 12 and by an outer covering panel 14, and in which each door (figure 1) is provided with respective fittings 32,42 and is connected to a side of the respective opening of the body (col. 4, lines 26-29) by means of adjustable hinges 40, a fixed portion of which is bolted to the body and a movable portion of which is bolted to the framework 12, wherein: doors (figure 1) are used in which the framework 12 and the outer covering panel 14 are constituted by two separated members, which are provided with reciprocal fixing means 263 arranged in positions such as not to be visible from the outside of the finished motor vehicle; the painting of the body (col. 2, lines 25-26) lacking the doors (figure 1) and the painting (col. 2, lines 25-26, “It is envisioned that the vehicle manufacturer will paint the outer skin 14

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simultaneously with the rest of the car, then attach door module **12** to the body and, finally, attach the outer panel **14** and interior trim pad or panel **16**.”) of the outer covering panels **14** is executed; the fittings **32,42** are installed on the framework of each door lacking the outer covering panel **14**; once the fittings **32,42** are installed, each door framework **12** lacking the outer covering panel **14** is installed in the respective opening; and the respective outer covering panel **14** is applied and fixed to the framework **12** of each installed door.

Regarding claim 5, the hinges **40** are considered to be “adjustable” on the framework **18**.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Herringshaw et al.

Regarding claim 2, Herringshaw et al. teach that the outer covering panels **14** (see figure 7) are used having edge folded flaps **250** or inserts defining a front wall arranged on the face of the panel facing the framework **18** in the installed condition and defining an interspace **252** between it and the corresponding edge zone of the panel, and wherein at least in part fixing means comprising a nut **268** are used, and a screw engageable with the nut, from the framework, through corresponding aligned holes formed in the framework in the front wall.

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Herringshaw et al. teach the invention cited with the exception of the nut being fastened to the front wall before painting the covering and the nut being located inside of the interspace.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have fastened the nut to the front wall before painting the covering and the nut being located inside of the interspace because applicant has not disclosed that fastening the nut to the front wall before painting the covering and the nut being located inside of the interspace provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the fastening taught by Herringshaw et al. or the claimed fastening because either fastening techniques perform the same function of securing the outer panel to the framework equally well. Therefore, it would have been an obvious matter of design choice to provide the invention of Herringshaw et al. with the features of claim 2.

Regarding claims 3-4, note the pins (inside of **270**) and screws **272**.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Marc Jimenez". The signature is fluid and cursive, with the first name "Marc" and last name "Jimenez" clearly distinguishable.

Marc Jimenez
Primary Examiner
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MJ

March 17, 2005